

5	Applicant: Matthias Muth	Group Art Unit: 2443
	Serial No.: 10/517,246	Examiner: Fearer, Mark D.
	Filed: December 7, 2004	Confirmation No.: 3106
	For: METHOD AND SYSTEM FOR SWITCHING BETWEEN SUBNETWORK OPERATION AND FULL NETWORK OPERATION	

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Sir/Madam:

20 This reply brief is in response to Examiner's Answer of April 29, 2010.

I. Status of Claims

Claims 1-15 were originally filed on December 7, 2007. In a preliminary amendment filed on December 7, 2007, claim 15 was canceled, and claims 3 and 6-8 were amended. In response to the Office Action of March 31, 2008, claims 1-14 were amended. In response to the Final Office Action of October 20, 2008, a Notice of Appeal was filed on March 24, 2009 and an Appeal Brief was filed on May 26, 2009. Claims 1-14 stand rejected in a non-final Office Action after reopening of prosecution and form the subject matter of the present appeal.

Claims 1, 4, 9 and 10-14 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-10 and 12-14 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,154,061 (“Boezen et al.”) in view of U.S. Patent No. 5,475,687 (“Markkula, Jr. et al.”). Claim 11 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Boezen et al. in view of Markkula, Jr. et al., and in further view of U.S. Patent No. 6,832,251 (“Gelvin et al.”).

This Appeal is made with regard to pending claims 1-14.

II. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1, 4, 9 and 10-14 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the
5 invention under 35 U.S.C. 112, second paragraph.

Whether claims 1-10 and 12-14 are unpatentable under 35 U.S.C. §103(a) over Boezen et al. in view of Markkula, Jr. et al.

10 Whether claim 11 is unpatentable under 35 U.S.C. §103(a) over Boezen et al. in view of Markkula, Jr. et al., and further in view of Gelvin et al.

III. Argument

A. Rejections of Claims 1, 4, 9 and 10-14 under 35 U.S.C. §112, Second Paragraph

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Claims 1, 4, 9 and 10-14 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. However, claims 1, 4, 9 and 10-14 do particularly point out and distinctly claim
10 the subject matter which Applicant regards as the invention, and thus, are definite under 35 U.S.C. 112, second paragraph.

i. Rejection of Claim 1 under 35 U.S.C. §112, Second Paragraph

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The Examiner on page 17 of the Examiner's Answer ("Response to Argument" section) has merely restated the rejection of claim 1 under 35 U.S.C. 112, second paragraph, without addressing the arguments in the Applicant's Appeal Brief of February 2, 2010 (hereinafter "Appeal Brief"). Applicant notes herein that the Section 112 rejection of claim 1 in the Examiner's answer
20 describes only the conclusion of the rejection and not any supporting rationale for the rejection. Thus, the Examiner's Answer has failed to provide "[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention" for claim 1, as required by the guidelines
25 set forth in MPEP 1207.02. Nevertheless, Applicant will address the rejection of claim 1 under 35 U.S.C. 112, second paragraph, in the Examiner's Answer.

As previously asserted in the Appeal Brief, claim 1 is clearly directed to a process, i.e., "[a] method for changing over a serially networked system." The
30 claimed method includes the limitation of "*characterized in that the system is changed over from the subnetwork operation to the full network operation through the detection of at least one defined, especially continuous and/or especially symmetrical signal level pattern in the data traffic on the system.*" Thus, claim 1 clearly recites at least the step of changing the system "*from the*
35 *subnetwork operation to the full network operation through the detection of at*

least one defined, especially continuous and/or especially symmetrical signal level pattern in the data traffic on the system.” Therefore, claim 1 clearly recites a process. As such, claim 1 does particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Consequently, claim 1 is
5 definite as required under 35 U.S.C. 112, second paragraph.

ii. Rejection of Claim 4 under 35 U.S.C. §112, Second Paragraph

Similar to the Section 112 rejection of claim 1, the Examiner on page 17 of
10 the Examiner’s Answer (“Response to Argument” section) has merely restated the rejection of claim 4 under 35 U.S.C. 112, second paragraph, without addressing the arguments in the Applicant’s Appeal Brief. Thus, the Examiner’s Answer has also failed to provide “[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and
15 an explanation of the reasons for disagreement with any such contention” for claim 4, as required by the guidelines set forth in MPEP 1207.02. Nevertheless, Applicant will address the rejection of claim 4 under 35 U.S.C. 112, second paragraph, in the Examiner’s Answer.

20 Claim 4 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner on page 4 of the Examiner’s Answer states that “[c]laim 4 does not describe the required step for performing a specified function as required by the sixth
25 paragraph of 35 U.S.C. 112.” However, claim 4 does not recite a means-plus-function element. Thus, Applicant respectfully asserts that the requirement under 35 U.S.C. 112, sixth paragraph, is not applicable to claim 4. Consequently, claim 4 is definite as required under 35 U.S.C. 112, second paragraph.

iii. Rejection of Claim 9 under 35 U.S.C. §112, Second Paragraph

Similar to the Section 112 rejections of claims 1 and 4, the Examiner on
pages 17 and 18 of the Examiner’s Answer (“Response to Argument” section) has merely restated the rejection of claim 9 under 35 U.S.C. 112, second paragraph,

without addressing the arguments in the Applicant's Appeal Brief. Thus, the Examiner's Answer has failed to provide "[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention" for claim 9, as required by the guidelines set forth in MPEP 1207.02. Nevertheless, Applicant will address the rejection of claim 9 under 35 U.S.C. 112, second paragraph, in the Examiner's Answer.

Claim 9 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner on page 4 of the Examiner's Answer states that "[d]ependent claim 9 is a product claim which depends on Claim 1, a method claim." However, claim 9 does particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Consequently, claim 9 is definite as required under 35 U.S.C. 112, second paragraph.

A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process. (See MPEP 2173.05(p)). In the case at hand, claim 9 contains a reference to the process as claimed in claim 1. However, claim 9 is clearly directed to the product, not the process as claimed in claim 1. As such, claim 9 does particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Consequently, claim 9 is definite as required under 35 U.S.C. 112, second paragraph.

iv. Rejections of Claims 10-13 under 35 U.S.C. §112, Second Paragraph

Similar to the Section 112 rejections of claims 1, 4 and 9, the Examiner on page 18 of the Examiner's Answer ("Response to Argument" section) has merely restated the rejections of claims 10-13 under 35 U.S.C. 112, second paragraph, without addressing the arguments in Applicant's Appeal Brief. Thus, the

Examiner's Answer has failed to provide "[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention" for claims 10-13, as required by the guidelines set forth in MPEP 1207.02. Nevertheless, Applicant will address the rejections of claims 10-13 under 35 U.S.C. 112, second paragraph, in the Examiner's Answer.

Claims 10-13 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner on page 4 of the Examiner's Answer states that "[d]ependent claims 10-13 are product claims which depends on Claim 9, which depends on Claim 1, a method claim." However, as explained above in section iii, claim 9 is a proper claim under 35 U.S.C. 112, second paragraph. Thus, claims 10-13 are also proper under 35 U.S.C. 112, second paragraph. Consequently, claims 10-13 are definite as required under 35 U.S.C. 112, second paragraph.

v. Rejection of Claim 14 under 35 U.S.C. §112, Second Paragraph

Similar to the Section 112 rejections of claims 1, 4 and 9-13, the Examiner on page 18 of the Examiner's Answer ("Response to Argument" section) has merely restated the rejection of claim 14 under 35 U.S.C. 112, second paragraph, without addressing the arguments in Applicant's Appeal Brief. Thus, the Examiner's Answer has failed to provide "[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention" for claim 14, as required by the guidelines set forth in MPEP 1207.02. Nevertheless, Applicant will address the rejection of claim 14 under 35 U.S.C. 112, second paragraph, in the Examiner's Answer.

Claim 14 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner on page 4 of the Examiner's Answer states that "[d]ependent claim 14

is a product claim which depends on Claim 13, which depends on Claim 9, which depends on Claim 1, a method claim.” However, as explained above in section iv, claim 13 is a proper claim under 35 U.S.C. 112, second paragraph. Thus, claim 14 is also proper under 35 U.S.C. 112, second paragraph. Consequently, claim 14 is definite as required under 35 U.S.C. 112, second paragraph.

B. Rejections Under 35 U.S.C. §103(a)

Claims 1-14 were rejected under 35 U.S.C. §103(a) over Boezen et al. in view of Markkula, Jr. et al. and/or Gelvin et al. However, the Examiner has failed to establish a *prima facie* case of obviousness for the independent claims 1 and 4, as explained in the Applicant’s Appeal Brief. Thus, the independent claims 1 and 4 and the dependent claims 2, 3 and 5-14 are not unpatentable under 35 U.S.C. §103(a) over Boezen et al. in view of Markkula, Jr. et al. and/or Gelvin et al.

i. Rejections of Claims 1 and 4 under 35 U.S.C. §103(a)

The Examiner on pages 18-22 of the Examiner’s Answer (“Response to Argument” section) has apparently attempted to address the arguments presented in the Applicant’s Appeal Brief with respect to the Section 103 rejections of claims 1 and 4. However, the response in the “Response to Argument” section of the Examiner’s Answer does not in fact address the arguments presented in the Applicant’s Appeal Brief. The response in the Examiner’s Answer merely recites the claimed language of the independent claim 1 with descriptions of various aspects of the cited references of Boezen et al. and Markkula, Jr. et al. that are injected at various locations of the claimed language without clear correspondence between the claimed features and the various aspects of the cited references. As a result, the Examiner has not addressed the arguments presented in the Applicant’s Appeal Brief.

In particular, the Examiner has not addressed the argument presented in the Applicant’s Appeal Brief that Markkula, Jr. et al. does not disclose the limitation of “*characterized in that the system is changed over from the subnetwork operation to the full network operation....*,” where “*the subnetwork*

operation” is defined as “in which at least one node and/or at least one user of the system is in a state of reduced current consumption...,” as recited in the independent claim 1. In addition, the Examiner has not addressed the argument presented in the Applicant’s Appeal Brief that Markkula, Jr. et al. does not disclose the limitation of changing over from the subnetwork to the full network “through the detection of at least one defined, especially continuous and/or especially symmetrical signal level pattern in the data traffic on the system,” as recited in the independent claim 1. Thus, the Examiner’s Answer has failed to provide “[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention” (emphasis added) for claims 1 and 4, as required by the guidelines set forth in MPEP 1207.02.

Applicant respectfully reasserts that the Examiner has failed to establish a *prima facie* case of obviousness for the independent claims 1 and 4, as explained in the Applicant’s Appeal Brief. Thus, the independent claims 1 and 4 are not obvious over Boezen et al. in view of Markkula, Jr. et al.

ii. Rejections of Dependent Claims 2, 3 and 5-14 under 35 U.S.C. §103(a)

Each of the dependent claims 2, 3 and 5-14 depends on one of the independent claims 1 and 4. As such, these dependent claims include all the limitations of their respective base claims. Thus, these dependent claims are patentable for at least the same reasons as their respective base claims. Furthermore, the dependent claims 2 and 5 are allowable for additional reasons.

Similar to the rejections of claims 1 and 4, the Examiner on pages 18-22 of the Examiner’s Answer (“Response to Argument” section) has apparently attempted to address the arguments presented in the Applicant’s Appeal Brief with respect to the Section 103 rejections of claims 2 and 5. However, the response in the Examiner’s Answer does not in fact address the arguments presented in the Applicant’s Appeal Brief with respect to claims 2 and 5. Thus, the Examiner’s

Answer has failed to provide “[a] statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention” (emphasis added) for claims 2 and 5, as required by the guidelines set
5 forth in MPEP 1207.02.

Applicant respectfully reasserts that the Examiner has failed to establish a *prima facie* case of obviousness for the dependent claims 2 and 5, as explained in the Applicant’s Appeal Brief. Thus, the dependent claims 2 and 5 are not obvious
10 over Boezen et al. in view of Markkula, Jr. et al.

SUMMARY

In the Examiner's Answer, the Examiner has failed to provide "[a] statement of whether the examiner disagrees with each of the contentions of
5 appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention," as required by the guidelines set forth in MPEP 1207.02. Furthermore, claims 1, 4, 9 and 10-14 do particularly point out and distinctly claim the subject matter which Applicant regards as the invention, and thus, are definite under 35 U.S.C. 112, second paragraph. In
10 addition, the Examiner has failed to establish a *prima facie* case of obviousness for the independent claim 1 using the cited references of Boezen et al. and Markkula, Jr. et al. since neither of these references discloses the claimed limitations of "*characterized in that the system is changed over from the subnetwork operation to the full network operation through the detection of at
15 least one defined, especially continuous and/or especially symmetrical signal level pattern in the data traffic on the system,*" where the subnetwork operation is described as "*in which at least one node and/or at least one user of the system is in a state of reduced current consumption and is not addressed and/or not activated by the signal level of the data traffic on the system.*" The Examiner has
20 similarly failed to establish a *prima facie* case of obviousness using the cited references of Boezen et al. and Markkula, Jr. et al. for the independent claim 4, which recites similar limitations as claim 1. The Examiner has also failed to establish a *prima facie* case of obviousness for the dependent claims 2, 3 and 5-14 since these dependent claims are patentable for at least the same reasons as their
25 respective base claims.

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For all the foregoing reasons, it is earnestly and respectfully requested that the Board of Patent Appeals and Interferences reverse the rejections of the Examiner regarding claims 1-14 so that this case may be allowed and pass to issue in a timely manner.

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Respectfully submitted,
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